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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
LIM, KRISNA	

ART UNIT	PAPER NUMBER
2453	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/784,446	EYAL, AVIV	
	Examiner	Art Unit	
	Krisna Lim	2453	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 December 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5,7 and 21-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 5, 7, 21-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. Claims 1, 5, 7 and 21 39 are once again presented for examination.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1, 5, 7 and 21-39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Katinsky et al. [U.S. Patent No. 6,452,609].

4. Katinsky discloses (e.g., see Figs. 1-17) the invention substantially as claimed. Taking claim 21 as an exemplary claim, the reference discloses a media distribution and playback system comprising:

a) a terminal-side subsystem (e.g., Fig. 10) being provided on a terminal and comprising a media playback component (e.g., see 1036 of Fig. 10) and a network browsing component (e.g., see browser components of Fig. 10), wherein the terminal-side subsystem is configured to enable a user-input that results in a search operation (generate query of Fig. 12) being performed using a database that stores information about a plurality of media resources, so that a search result is identifiable from the user-input (e.g., see Fig. 12);

b) the terminal-side subsystem (1004 of Fig. 10) being configured to receive one or more commands communicated from a server-side subsystem (1002 of Fig. 10) of the system over a network (e.g., see Fig. 10); wherein at least one of the terminal or server-side subsystem is configured to provide the search result as a play-list that is playable on the terminal-side subsystem, the play-list being playable automatically and responsively to the user specifying the user-input of the search operation (a sequencer which displays play lists that defines an order in which media objects are played by the player, see col. 1, line 52, to col. 2, line 65); wherein the media playback component is at least partially and directly controllable by at least one of the commands (a web page with a player for playing media objects, a sequencer which displays a play list that defines an order in which media objects are played by the player, col. 1, line 52, to col. 2, line 65) that is received from the server-side portion over the network, the media playback component using the at least one of the commands to continuously playback two or more media resources (e.g., see col. 1, line 52, to col. 2, line 65) that are at least partially accessible over the network, including at least one media resource identified from the search result; wherein the network browsing component is at least partially controllable by at least one of the terminal-side subsystem or at least one of the one or more commands, in order to display information associated with at least one media resource identified in the search result (e.g., see col. 1, line 52, to col. 2, line 65).

While Katinsky discloses the sequencer which displays play lists that defines an order in which media objects are played by the player (e.g., see Fig. 11, user plays play list of Fig. 14) and the user who controls and manipulates the play lists (e.g., see col. 1, line, 52, to col. 2, line 65, col. 3, line 45, to col. 4, line 16) and the search result that generates the play list (e.g., see Fig. 8A), Katinsky does not explicitly mention that the search result as a play-list being playable automatically. It would, however, have been obvious to one of ordinary skilled in the art at the time the invention was made to recognize that a play-list which is generated by the search result is obviously the order for a player to play automatically because the play list is known as an order for the player to play automatically.

5. As to claim 22, Katinsky discloses the network browsing component (e.g., see browser components of Fig. 10, col. 1, line 52, to col. 2, line 65) is operable to enable a user to interact with the system and to provide the user-input (tabs of the media access area).

6. As to claim 23, Katinsky discloses the network browsing component is operable with the media playback component without requiring any user- input (e.g., a sequencer, see col. 1, line 52, to col. 2, line 65).

7. As to claim 24, Katinsky discloses the at least one media resource identified from the search result is directly streamed to the media playback component from the server-side portion of the system (e.g., see col. 2, lines 31-37).

8. As to claim 25, Katinsky discloses at least one of the two or more media resources that are continuously played back include an advertisement (e.g., the banner) or a copyright notice (e.g., see col. 2, lines 5-30).

9. As to claim 26, Katinsky discloses at least one of the two or more media resources is played back automatically (e.g., a sequencer) and in response to the user-input based that result in the search operation (e.g., see col. 1, line 52, to col. 2, line 5O).

10. As to claim 27, Katinsky discloses at least one of the two or more media resources that are continuously played back include an advertisement (e.g., the banner) or a copyright notice (e.g., see col. 2, lines 5-30).

11. As to claim 28, Katinsky discloses at least one of the two or more media resources is played back from a result of a past search operation that was performed by

a user using the system (e.g.., see col. 7, lines 23-25).

12. As to claim 29, Katinsky discloses a database (e.g., see content DB 1010, Interface DB 1012, User Interface 1014) that stores information for enabling the search operation to be performed to identify the search result.

13. As to claim 30, Katinsky discloses the database resides at least partially on the terminal so as to be part of the terminal-side subsystem (e.g., see User database data resource objects, Interface and content data source objects of Fig. 10).

14. As to claim 31, Katinsky discloses a device on which the terminal-side subsystem is provided corresponds to anyone of a cellular device, a portable computer with non-cellular wireless communication capabilities, or a laptop or personal computer.

15. Claims 1, 5, 7 and 32-39 are similar in scope as of claims 21-31, and therefore claims 1, 5, 7 and 32-39 are rejected for the same reasons set forth above for claims 21-31.

16. Applicant's arguments filed 12/01/08 have been fully considered but they are not persuasive. In the remark, applicant argues that Katinsky requires the user to drag or otherwise place individual URL links into the sequencer when links are provided as part of a user-initiated search operation. In response, it is true that Katinsky does teach the feature as the applicant argues; however, Katinsky does teach also the feature as claims. For example, Katinsky clearly teaches the sequencer for displaying play lists and the play lists define order in which media objects are automatically played by the player (e.g., see Fig. 11, user plays play list of Fig. 14). Moreover, to the extent of the claimed language, the argument of having the user to drag or place individual URL links into the sequencer is not explicitly recites in the rejected claims.

17 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. .Claims 1, 5, 7 and 21-39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 28-38 of U.S. Patent No. 6,389,467. Although the conflicting claims are not identical, they are not patentably distinct from each other because they all are directed to a system for controlling the playing back media based on a search result. And, the difference is obvious because they all are similar in content and meaning. Thus, the difference is how the claimed language is drafted.

19. Claims 1, 5, 7 and 21-39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No.

6,519,648. Although the conflicting claims are not identical, they are not patentably distinct from each other because they all are directed to a system for controlling the playing back media based on a search result. And, the difference is obvious because they all are similar in content and meaning. Thus, the difference is how the claimed language is drafted.

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20. Claims 1, 5, 7 and 21-39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,725,275. Although the conflicting claims are not identical, they are not patentably distinct from each other because they all are directed to a system for controlling the playing back media based on a search result. And, the difference is obvious because they all are similar in content and meaning. Thus, the difference is how the claimed language is drafted.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956 The examiner can normally be reached on Monday to Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne, can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

February 5, 2009

/Krisna Lim/
Primary Examiner, Art Unit 2453